IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Hyun-Jeong KIM	Group Art Unit: 2686
Serial No.: 09/734,852	Examiner: LY, Nghi H.
Filed: December 11, 2000	Docket: 678-578 (P9616)

For: **METHOD OF NOTIFYING A CALLER OF MESSAGE CONFIRMATION IN A WIRELESS COMMUNICATION SYSTEM**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Sir:

This Reply Brief is submitted pursuant to 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on June 15, 2006, in the above-identified application.

Initially, it is respectfully submitted that the Examiner mischaracterizes the Applicant's description of the prior art as a description of the invention of the present application. Applicant describes Itoh, on pages 5 and 7 of the Appeal Brief, as follows:
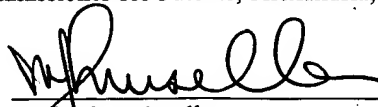
More specifically, Itoh, discloses that if a called terminal receives a message from a calling terminal, the called terminal transmits an answering signal without

regard to if a called party confirms a message or not to enable the calling terminal to check if the called terminal correctly received the message. That is, the calling terminal cannot check if the **called party** has confirmed the message, but can only check that the message is received in the called terminal. As Choksi deals with a receipt notification containing a telephone number, and not if a calling terminal can check if the **called party** has confirmed the message, Choksi does not cure this defect. (Appeal Brief, page 5, second paragraph.)

More specifically, Itoh, discloses that if a called terminal receives a message from a calling terminal, the called terminal transmits an answering signal without regard to if a called party confirms a message or not to enable the calling terminal to check if the called terminal correctly received the message. That is, the calling terminal cannot check if the **called party** has confirmed the message, but can only check that the message is received in the called terminal. (Appeal Brief, page 7, second paragraph.)

The Examiner mistakenly opines that this description of the prior art somehow correlates to a characterization by the Applicant of the present invention. (See Answer, page 9, second paragraph.) The Examiner then goes on to raise a new issue that "the features upon which the applicant relies (i.e., the calling terminal can check if the called party has confirmed the message) are not recited in the rejected claim(s)." (Answer at page 10.) The description by the Applicant of the prior art (i.e. Itoh) must be limited to exactly that, a description of the prior art. Any other implications are improper.

The two pending independent claims, namely Claims 16 and 21, clearly recite the features of the present invention upon which this Appeal is based. Claim 16 recites specific features. Among these is a method of communicating a confirmation message. First, the called mobile station informs the calling mobile station of receipt of a message. That is, when a message is received by a called mobile station, the called mobile station informs the calling mobile station that it has received the message. This is the first time the called mobile station sends a message to the calling mobile station. After this initial informing of the receipt of the message, a determination is made.

The determination is made based on a condition, i.e. if the received message is a text message. This determination (a method step, a verb) is equated to "electronic mail" (an object, a

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noun) of John. (Answer at page 5, second paragraph.) John does not determine if a received message is a text message.

Then, only if the received message is a text message will it be determined if a called party of the called mobile station has confirmed the received message. Informing of receipt of the message (described above) is different and separate from determining if a called party has confirmed the received message.

These two separate and distinct steps are mischaracterized in the Examiner's Answer. In the Answer it is alleged that the "answer signal" reads on the determination if the receipt of the message is confirmed by the called mobile station (see Answer at page 9, first paragraph), when in fact Itoh describes its answer signal as merely that, a verification of receipt of a message. This answer signal might be comparable to the called mobile station informing the calling mobile station of receipt of a message, but can in no way be equated to determining if a received message is confirmed.

Confirming a received message is described in the specification as follows: "In step 400, the controller 100B checks whether the called [mobile station] has read the text message and then entered key data related to confirmation of the text message via the keypad 140B." (Specification at page 9, lines 15-17.) Therefore, as defined by the specification, and as claimed in Claim 16, the confirming of the received message requires the message to be read and key data to be entered at the called terminal. This is improperly equated with the answer signal of Itoh, since the answer signal of Itoh merely verifies that a message is received, and is not that the message has actually been confirmed by the called mobile station.

The Examiner, in the Answer on page 9, last paragraph, goes on to mischaracterize "if a called party of the called mobile station has confirmed the received message" by again inappropriately equating the answer signal of Itoh (a signal sent to verify receipt of a message), with the confirming a receive signal of Claim 16.

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The Examiner also again alleges that John discloses that the received message "is stored in the called mobile station" as recited in Claim 16. (See Answer at page 5, second paragraph.) John states at col. 1, lines 22-23, "The voice message is stored in a mailbox assigned to the called party *in a voice message system*." (Emphasis added.) The voice message system (VMS1) is shown in FIG. 1 of John as separate and distinct from the mobile station (MS1). The message of John is not stored in the called mobile station.

As described above, the called mobile station confirms the received message. Claim 16 recites that after the received message is confirmed by the called mobile terminal, a confirmation message is generated by the called mobile station. John does not disclose a called mobile station generating a message. Any messages of John are generated by the voice messaging system as clearly disclosed at col. 5, lines 10-36, and not generated by the called mobile terminal.

Claim 16 goes on to recite "transmitting, from the called mobile station, a confirmation message to be delivered to the calling mobile station". This is a second message that is transmitted from the called mobile terminal to the calling mobile terminal. None of the references either alone or in combination, teach or disclose transmitting both a receipt notification and a confirmation message.

Similarly to Claim 16, Claim 21 recites a method of communicating a confirmation message. The method includes determining, when a voice call is not normally established between a called mobile station and a calling mobile station, if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station; generating, by the called mobile station, a confirmation message indicating the confirmation by the called party; and transmitting, from the called mobile station, the confirmation message to the calling mobile station. These features are similar to those recited in Claim 16, and the arguments presented above with respect to Claim 16 therefore also apply to Claim 21.

Based on at least the foregoing, as the Examiner has failed to make out a prima facia case for an obviousness rejection, the rejection of Claims 16 and 21 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.
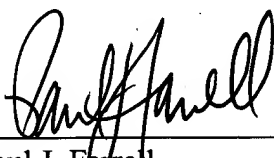
The Examiner has failed to show that all of the recitations of Claim 16 are taught in or suggested by the prior art. The Examiner has failed to make out a prima facia case for an obviousness rejection.

The Examiner has failed to show that all of the recitations of Claim 21 are taught in or suggested by the prior art. The Examiner has failed to make out a prima facia case for an obviousness rejection.

Independent Claim 16 is not rendered unpatentable by John in view of Itoh and Choksi, thus Claims 16-20 are allowable.

Independent Claim 21 is not rendered unpatentable by John in view of Itoh, thus Claims 21-27 are allowable.

Dated: August 15, 2006

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